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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,428	12/06/2001	Philip Rodney Kwok	P 282771	9777

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EXAMINER

LEWIS, AARON J

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 07/03/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/004,428

Applicant(s)

KWOK ET AL.

Examiner

AARON J. LEWIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/791,212.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7,9-11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claim Objections

Claim Objections

1. Claim 25 is objected to because of the following informalities: In line 7, "...surround wearer's nose..." should read --surround a wearer's nose--. Appropriate correction is required.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 24,25,28,29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 44,32 of copending Application No. 09/566,806. Although the conflicting claims are not identical, they are not patentably distinct from each other because for the reasons set forth below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

As to claim 24, a nasal mask cushion to sealingly connect a mask to a wearer's face, the cushion comprising (see preamble of claim 44): a nasal bridge region, a cheek region and a lip region (line 3 of claim 44); a first membrane comprising a substantially triangularly-shaped frame of resilient material having a first molded inwardly curved rim of said first membrane (lines 4 and 5 of claim 44); and a second membrane of resilient material, said second membrane being thinner and more flexible than said first membrane, said second membrane having a second molded inwardly curved rim, said second membrane curved rim spaced a distance from said first membrane curved rim, said distance greater than a thickness of the first molded inwardly curved rim, said distance measured when the mask is not in use, a portion of said second membrane curved rim forming a face contacting seal (lines 6-11 of claim 44).

The differences between claim 24 and claim 44 are additional limitations in application claim 24 including a more flexible second membrane. Each of claims 24 and 44 define the first and second membranes as resilient material, the second membrane being thinner than the first. It stands to reasons that a thinner membrane made of resilient material would be inherently more flexible than a thicker membrane of resilient material. Therefore, the recitation in claim 24 of the second membrane being more flexible than the first would be an inherent property of the second membrane as defined in claim 44. consequently, claim 24 is not patentably distinct from claim 44 because it is anticipated by claim 44. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

As to claim 25, a nasal mask for connection to a wearer's face comprising: a mask body for connection with a supply of breathable gas (see preamble of claim 32 of

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application ('506)); and a nasal cushion secured to said mask body, the body and cushion forming a nose-receiving cavity (lines 3 and 4 of claim 32), said cushion including: a nasal bridge region, a cheek region and a lip region (line 5 of claim 32); a substantially triangularly-shaped first membrane of resilient material having a first molded inwardly curved rim to surround a wearer's nose (lines 6-8 of claim 32); and a second membrane also of resilient material, said second membrane being more flexible than said first membrane, said second membrane having a second molded inwardly curved rim, said second molded rim being of the same general shape as said first molded rim and fixed to and extending away from said first membrane so as to have a second membrane inner surface spaced a distance from an outer surface of said first molded rim, said distance greater than a thickness of the first molded inwardly curved rim, said first distance measured when the mask is not in use, a portion of said second molded rim forming a face contacting seal (lines 9-14 of claim 32); wherein said seal portion is substantially coterminous with respect to said second molded rim and is resiliently deformable towards said first membrane in use of said mask.

The difference between claim 32 of application ('506) and claim 25 of the instant application is the additional recitation in claim 32 of at least a portion of the second molded rim remaining spaced from the first molded rim when the mask is connected to the wearer's face (lines 16-18 of claim 32); consequently, claim 32 includes more limitations than claim 25. Thus the invention of claim 32 is in effect a "species" of the "generic" invention of claim 25. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

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Claims 28 and 29 are substantially equivalent in scope to claims 24 and 25, respectively and are anticipated by claims 44 and 32 of application ('506) for the reasons set forth above with respect to each of claims 24 and 25.

3. Claims 26 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,112,746. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reason set forth below.

As to claim 26, a nasal CPAP treatment apparatus comprising (see preamble of claim 18): a flow generator for the supply of gas at a pressure elevated above atmospheric pressure (lines 2-3 of claim 18); a gas delivery conduit coupled to said flow generator; and a nasal mask in turn coupled to said conduit to said nasal mask (lines 4-6 of claim 18) including: a mask body for connection with a supply of breathable gas; and a nasal cushion secured to said mask body, the body and cushion forming a nose-receiving cavity (lines 7-10 of claim 18), the cushion including: a nasal bridge region, a cheek region and a lip region (line 12 of claim 18); a substantially triangularly shaped first membrane of resilient material having a first membrane having a first inwardly curved rim (lines 13-15 of claim 18); and a second membrane having a second molded inwardly curved rim also of resilient material, said second membrane being relatively more flexible than said first membrane, and being of the same general shape as said first molded inwardly curved rim and fixed to and extending away from said first membrane so as to have an inner surface spaced a distance from said first molded rim, said distance greater than a thickness of the first inwardly curved rim, said distance

measured when the mask is not in use, a portion of said second molded rim forming a face contacting seal (lines 16-28 of claim 18); wherein said seal portion is generally coterminous with respect to said second molded rim and is resiliently deformable towards said first membrane in use of said mask (lines 30-33 of claim 18).

The differences between claim 18 of application ('506) and claim 26 of the instant application include the recitations said second membrane inner surface spaced a second distance from said first molded rim, said second distance greater than said first distance; consequently, claim 18 includes more elements and is thus more specific. Thus the invention of claim 18 is in effect a "species" of the "generic" invention of claim 26. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

Claim 30 is substantially equivalent in scope to claim 26 and is anticipated by claim 18 of patent ('746) for the reasons set forth above with respect to claim 26.

4. Claims 27 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,112,746. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth below.

As to claim 27, a nasal mask cushion for sealingly connecting a mask to a wearer's face (see preamble of patent claim 1), comprising: a substantially triangularly-shaped frame of resilient material having a first membrane, the first membrane including a first molded inwardly curved rim (lines 4-6 of claim 1); and a second membrane of resilient material, said second membrane being more flexible than said first membrane, said

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second membrane having a second molded inwardly curved rim, said second membrane curved rim spaced a distance from said first membrane curved rim, said distance greater than a thickness of the first molded inwardly curved rim, said distance measured when the mask is not in use, a portion of said second membrane curved rim forming a face contacting seal (lines 7-18 of claim 1).

The differences between claim 27 and claim 1 include recitations of said second membrane curved rim spaced a first distance from said first membrane curved rim in said cheek region and said second membrane curved rim spaced a second distance from said first membrane curved rim in said nasal bridge region, said second distance greater than said first distance; consequently, claim 1 includes more elements and is thus more specific. Thus the invention of claim 1 is in effect a "species" of the "generic" invention of claim 27. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

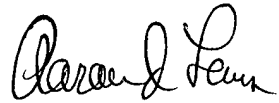
Claim 31 is substantially equivalent in scope to claim 27 and is anticipated by claim 1 of patent ('746) for the reasons set forth above with respect to claim 27.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON J. LEWIS whose telephone number is (703) 308-0716. The examiner can normally be reached on 9:30AM-6:00PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WEILUN LO can be reached on (703) 308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A handwritten signature in black ink, appearing to read "Aaron J. Lewis".

AARON J. LEWIS
Primary Examiner
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Aaron J. Lewis
June 28, 2003